



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,912	02/11/2004	Milo S. Medin	19675-08643	6075
758	7590	11/21/2005		
FENWICK & WEST LLP SILICON VALLEY CENTER 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041			EXAMINER NEURAUTER, GEORGE C	
			ART UNIT 2143	PAPER NUMBER

DATE MAILED: 11/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/777,912	<b>Applicant(s)</b> MEDIN, MILO S.	
	<b>Examiner</b> George C. Neurauter, Jr.	<b>Art Unit</b> 2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                                                        |                                                                                         |
|--------------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>08252005,08292005</u> . | 6) <input type="checkbox"/> Other: _____                                                |

Art Unit: 2143

**DETAILED ACTION**

Claims 1-3 are currently presented and have been examined.

***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on 25 August 2005 was filed after the mailing date of the non-final rejection on 14 March 2005. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

The information disclosure statement filed 29 August 2005 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the IDS reference fails to comply with 37 CFR 1.98(b)(5). It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

***Terminal Disclaimer***

Art Unit: 2143

The terminal disclaimer filed on 26 August 2005 disclaiming the terminal portion of any patent granted on this application that would extend beyond the expiration date of US Patent 6 370 571 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Response to Arguments***

Applicant's arguments filed 17 October 2005 have been fully considered but they are not persuasive.

The Applicant argues that Donahue does not qualify as prior art under 35 USC 102(e). Donahue claims priority to provisional application 60/029,427 filed 12 November 1996 and provisional application 60/039,672 filed 28 February 1997, anticipating the priority of the instant application filing date of 5 March 1997. Therefore, Donahue qualifies as prior art under 35 USC 102(e).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United

Art Unit: 2143

States and was published under Article 21(2) of such treaty in the English language.

Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6 101 180 to Donahue et al.

Regarding claim 1, Donahue discloses a method for delivery of high-performance online multimedia services comprising:

assigning general content to be multicast to a multicast destination address; (column 8, lines 7-25)

customizing the general content to suit a first area and thus forming a first version of the content; customizing the general content to suit a second area and thus forming a second version of the content; multicasting the first version to an end-user system in the first area; and multicasting the second version to an end-user system in the second area. (column 5, lines 27-45, specifically lines 30-32 and 37-40; column 5, lines 55-58)

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2143

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donahue in view of "Cable Modem Termination System - Network Side Interface Specification ("CTMS-NSIS").

Regarding claim 2, Donahue discloses the method of claim 1.

Donahue does not expressly disclose wherein the first area corresponds to a region served by a first regional data center, and the second area corresponds to a region served by a second regional data center, however, "CTMS-NSIS" discloses these limitations (page 3, "Cable Modem Termination System", specifically "distribution hub")

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of these references since "CTMS-NSIS" discloses that the regional data centers allow data to sent over coaxial networks (page 1, "1. Scope and Purpose", first paragraph) and implements

Art Unit: 2143

multicasting of data to specific end users (page 6, "IP multicast addressing and forwarding"). In view of these specific advantages and that the references are directed to multicasting of data to end users, one of ordinary skill would have been motivated to combine these references and would have considered them to be analogous to one another based on their related fields of endeavor.

Regarding claim 3, Donahue discloses the method of claim 2.

Donahue does not disclose wherein the first area corresponds to a locality served by a first modified head-end, and the second area corresponds to a locality served by a second modified head-end, however, "CTMS-NSIS" discloses these limitations (page 3, "Hybrid Fiber/Coax (HFC) System", specifically "fiber node")

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of these references since "CTMS-NSIS" discloses that the modified head ends allow data to sent over coaxial networks (page 1, "1. Scope and Purpose", first paragraph) and implements multicasting of data to specific end users (page 6, "IP multicast addressing and forwarding"). In view of these specific advantages and that the references are directed to multicasting of data to end users, one of ordinary skill would have been

Art Unit: 2143

motivated to combine these references and would have considered them to be analogous to one another based on their related fields of endeavor.

**Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C. Neurauter, Jr. whose telephone number is (571) 272-3918. The examiner can normally be reached on Monday through Friday from 9AM to 5:30PM Eastern.

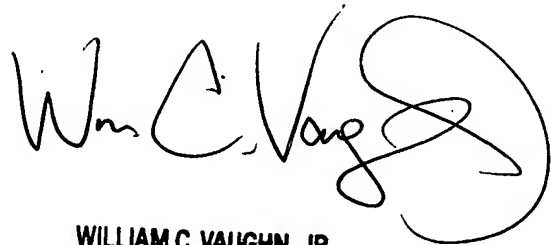


Art Unit: 2143

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

gcn

A handwritten signature in black ink, appearing to read 'Wm C. Vaughn, Jr.', enclosed within a large, loopy circular flourish.

WILLIAM C. VAUGHN, JR.  
PRIMARY EXAMINER